

AMENDMENTS TO THE DRAWINGS

One replacement sheet of FIG. 3 is attached following page 19 of this paper. The Applicant has placed an identification number "306" for the access device designated as "D", in accordance with the description of FIG. 3 in paragraphs 47-48 of the specification. Therefore, the Applicant submits that no new matter has been introduced by the replacement sheet of FIG. 3.

REMARKS / ARGUMENTS

The present application includes pending claims 1-30, all of which have been rejected. By this Amendment, claims 1, 3-4, 8-21, 23-24, and 28-30 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 11-20 were rejected under 35 USC § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-4, 8-14, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,947,768, issued to Adachi, et al. (hereinafter, Adachi), in view of U.S. Patent No. 5,640,678, issued to Ishikawa (hereinafter, Ishikawa). Claims 5-7, 15-17 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in view of Ishikawa, and further in view of U.S. Patent Publication No. 2002/0077151, issued to Matthews, et al. (hereinafter, Matthews). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. REJECTION UNDER 35 U.S.C. § 101

The Applicant now turns to the rejection of claims 11-20 under 35 U.S.C. § 101 as being non-statutory because the claimed invention is allegedly directed to non-statutory subject matter. The Office Action states the following:

Claims 11-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For claim 11, the claim falls within a statutory category and includes a judicial exception but has no practical application. Claims 12-20 are rejected because they depend on claim 11.

See the Final Office Action at page 2. The Applicant points out that claims 11-20 have been amended, as set forth above, so that the claims now relate to a "computer-readable medium" instead of a "machine-readable storage." The Examiner is referred to the following citation from the MPEP:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, **"functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) **"Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.**

See Manual of Patent Examining Procedure (MPEP), Chapter 2100.6. The Applicant points out that the descriptive material in the preamble of claim 11 is not related to "music, literary works, and a compilation or mere arrangement of data." Instead, the Applicant submits that the descriptive material in the preamble of claim 11 is related to "computer programs which impart functionality when employed as a computer component." In other words, the material in the preamble of claim 11 is "functional

descriptive material." The Examiner is also referred to the following MPEP citation for support:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

See *id.* The Applicant, therefore, submits that the material in the preamble of claim 11 is functional descriptive material, which is also statutory, as per the above MPEP guidelines. The Applicant submits that claims 11-20 are directed to statutory subject matter. Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of claims 11-20 be allowed. The Applicant reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

II. REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

A. Rejection of Claim 1

Claims 1-4, 8-14, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi, in view of Ishikawa. With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Adachi and Ishikawa does not disclose or suggest at least the limitation

of "wherein said at least one of said plurality of access devices maintains a handoff candidate list and ...wherein said second wireless access point is selected from said handoff candidate list," as recited by the Applicant in independent claim 1.

The Applicant has reviewed Adachi and Ishikawa and points out that neither Adachi nor Ishikawa teach an access device, which maintains a handoff candidate list. Furthermore, neither Adachi nor Ishikawa disclose or suggest that a wireless access point is selected from the handoff candidate list maintained by the access device.

Therefore, the Applicant maintains that the combination of Adachi and Ishikawa does not disclose or suggest at least the limitation of "wherein said at least one of said plurality of access devices maintains a handoff candidate list and ...wherein said second wireless access point is selected from said handoff candidate list," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Adachi and Ishikawa does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-4, 8-10, 12-14, 18-20, 22-24, and 28-

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Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa has been overcome and request that the rejection be withdrawn. Additionally, claims 2-4 and 8-10, 12-14 and 18-20, and 22-24 and 28-30 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-4, 8-14, 18-24, and 28-30.

C. Rejection of Dependent Claims 5-7, 15-17, and 25-27

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being anticipated by Adachi in view of Ishikawa has been overcome and request that the rejection be withdrawn. Additionally, since the additional cited reference (Matthews) does not overcome the deficiencies of Adachi and Ishikawa, claims 5-7, 15-17, and 25-27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5-7, 15-17, and 25-27.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 15-NOV-2007

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